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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/651,030	08/29/2003	Hiroko Sukeda	500.43074X00	8517

24956 7590 09/11/2007
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EXAMINER

WORJLOH, JALATEE

ART UNIT	PAPER NUMBER
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3621

MAIL DATE	DELIVERY MODE
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09/11/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/651,030	Applicant(s) SUKEDA ET AL.	
	Examiner Jalatee Worjloh	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-12, 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group II (Claims 13-18) in the reply filed on 6-14-07 is acknowledged.
2. Claims 1-12, 19 and 20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 6-14-07.
3. Election/Restriction requirement is FINAL.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 13-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Claim 13 recites the limitation "the point management program as claimed in claim 1" in lines 9 and 10. However, claim 1 has been withdrawn from consideration. There is insufficient antecedent basis for this limitation in the claim.
7. Claim 14 recites the limitation "the point management program as claimed in claim 2" in lines 9 and 10. However, claim 2 has been withdrawn from consideration. There is insufficient antecedent basis for this limitation in the claim.

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8. Claim 15 recites the limitation "the point management program as claimed in claim 3" in lines 9 and 10. However, claim 3 has been withdrawn from consideration. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 16 recites the limitation "the point management program as claimed in claim 1" in lines 2 and 3. However, claim 1 has been withdrawn from consideration. There is insufficient antecedent basis for this limitation in the claim.

10. Claim 17 recites the limitation "the point management program as claimed in claim 2" in lines 2 and 3. However, claim 2 has been withdrawn from consideration. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 13 – 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6014634 to Scroggie et al. ("Scroggie") in view of JP Publication No. 2002-163537 to Yamada et al. ("Yamada").

Referring to claim 13, Scroggie discloses a control unit, a communication unit for carrying out communication with the network, and the control unit generates a customer ID according to a request from a user at a computer and sends to a computer a point management program (i.e. purchasing incentive) with the generated customer ID incorporated therein (see

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col. 1, lines 65-67; col. 2, lines 1-7; col. 3, lines 25-32; fig. 13 –fig. 14). Scroggie does not expressly disclose a portable terminal. Yamada discloses a point management system using portable information terminal (see abstract). At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the server disclose by Scroggie to include a portable terminal. One of ordinary skill in the art would have been motivated to do this because it is not regarded as inventive to merely make an old device portable or movable without producing any new and unexpected result (see *In re Lindberg*, 93 USPQ 23 (CCPA)).

Claims 14 and 15 teach the server of claim 13; therefore, these claims are rejected on the same rationale as claim 13 above.

Referring to claim 16, Scroggie discloses a data input unit for acquiring data, a data output unit and a program execution unit (see abstract; fig. 13 – fig. 15; the in-store server and kiosk are known to have these components) and the program executed by the program execution unit comprises the steps of: acquiring customer ID data output form an output unit of the computer through the data input unit, generating output data including input point data and the customer ID data and outputting the output data through the data output unit (see abstract; fig. 13-15).). Scroggie does not expressly disclose a portable terminal. Yamada discloses a point management system using portable information terminal (see abstract). At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the server disclose by Scroggie to include a portable terminal. One of ordinary skill in the art would have been motivated to do this because it is not regarded as inventive to merely make an old device portable or movable without producing any new and unexpected result (see *In re Lindberg*, 93 USPQ 23 (CCPA)).

Referring to claim 17, Scroggie discloses a data input unit for acquiring data, a data output unit, a display unit and a program execution unit (see abstract; fig. 13 – fig. 15; the in-store server and kiosk are known to have these components) and the program executed by the program execution unit comprises the steps of: acquiring customer ID data output from an output unit of the computer through the data input unit, conducting customer information analysis using the acquired result of the customer information analysis and input point data, for display on the display unit, generating output data including input point data and the customer ID data and outputting the output data through the data output unit (see abstract; fig. 13-15)). Scroggie does not expressly disclose a portable terminal. Yamada discloses a point management system using portable information terminal (see abstract). At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the server disclose by Scroggie to include a portable terminal. One of ordinary skill in the art would have been motivated to do this because it is not regarded as inventive to merely make an old device portable or movable without producing any new and unexpected result (see *In re Lindberg*, 93 USPQ 23 (CCPA)).

Referring to claim 18, Scroggie discloses the apparatus, wherein the output data is encrypted as an arrangement of numbers and is printed on paper (see fig. 1; col. 2, lines 65-67 – encoded incentive/the token, which is known to be encrypted).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 571-272-6714. The examiner can normally be reached on Monday - Friday 9:30 - 6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jaratee Worjloh
Primary Examiner
Art Unit 3621

September 3, 2007